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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,981	01/21/2005	Gerald Adams	J3682(C)	1485

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EXAMINER	
VU, JAKE MINH	
ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
04/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/521,981	ADAMS ET AL.	
	Examiner	Art Unit	
	JAKE M. VU	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/8/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Applicant's Information Disclosure Statement filed on 04/08/2005 and Preliminary Amendment filed on 01/21/02005.

- Claims 1-8 are pending in the instant application.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 10/521,982 in view of YUUKI et al (JP 08-092043) and BOLICH (US 4,764,363).

Application '982 recites a hair treatment composition comprising of: 2-hydroxyalkanoic acid, such as 2-hydroxyocatnoic acid (see claims 1 and 2); and 0.1 to 10 wt% of a styling aid (see claim 1), wherein the styling aid is a polymer (see claim 4). The hair treatment composition is a leave on product (see claim 6), wherein the composition could be used for a method of styling hair (see claim 7) by applying to the hair a composition comprising a 2-hydroxyalkanoic acid (see claim 7).

Application '892 does not teach using a propellant or a surfactant.

YUUKI teaches a method of holding the hair modification over a long period of time (see [0005]), which would read on styling hair, by applying (see [0002] and [0038]) to the hair an aerosol (see [0038]), which would read on mousse composition, comprising of: 1-20% (see [0028]) of a hydroxyalkanoic acid, such as 2-hydroxyoctanoic acid (see [0025]); a surface active agent (see [0031]), which would read on surfactant; and a styling polymer (see [0033]), wherein the composition impart humidity resistance to the hair (see [0001] and [0005]).

BOLICH teaches that the agent responsible for expelling the materials from the container and forming the mousse character is a propellant (see col. 2, line 49-51)

It would have been obvious to the person of ordinary skill in the art at the time the invention was made to incorporate a propellant and surfactant into Application '891 hair treatment composition. The person of ordinary skill in the art would have been

motivated to make those modifications and reasonably would have expected success because mousse is well known in the industry as a form of hair treatment composition, while propellants and surfactants are commonly used in mousse, and propellants is the key ingredient that expels and forms the mousse composition.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 8 provides for the use of a mousse, but since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7 and 8 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). In this instance, Applicant's use of a mousse does not set forth any steps involved in the process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by YUUKI et al (JP 08-092043).

Applicant's claims are directed to a method of styling hair by applying to the hair a hair treatment mousse composition comprising of: 0.5-10% of a hydroxyalkanoic acid, such as 2-hydroxyoctanoic acid; a surfactant; and a styling polymer, wherein the composition impart humidity resistance to the hair.

YUUKI teaches a method of holding the hair modification over a long period of time (see [0005]), which would read on styling hair, by applying (see [0002] and [0038]) to the hair an aerosol (see [0038]), which would read on mousse composition,

comprising of: 1-20% (see [0028]) of a hydroxyalkanoic acid, such as 2-hydroxyoctanoic acid (see [0025]); a surface active agent (see [0031]), which would read on surfactant; and a styling polymer (see [0033]), wherein the composition impart humidity resistance to the hair (see [0001] and [0005]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over YUUKI et al (JP 08-092043) in view of BOLICH (US 4,764,363).

As discussed above, YUUKI teaches a method of holding the hair modification over a long period of time (see [0005]), which would read on styling hair, by applying (see [0002] and [0038]) to the hair an aerosol (see [0038]), which would read on mousse composition, comprising of: 1-20% (see [0028]) of a hydroxyalkanoic acid, such as 2-hydroxyoctanoic acid (see [0025]); a surface active agent (see [0031]), which would read on surfactant; and a styling polymer (see [0033]), wherein the composition impart humidity resistance to the hair (see [0001] and [0005]).

YUUKI does not teach using a propellant in the hair mousse composition.

BOLICH teaches that the agent responsible for expelling the materials from the container and forming the mousse character is a propellant (see col. 2, line 49-51)

It would have been obvious to the person of ordinary skill in the art at the time the invention was made to incorporate a propellant into YUUKI's aerosol composition. The person of ordinary skill in the art would have been motivated to make those modifications and reasonably would have expected success because propellants are commonly used in mousse and is the key ingredient that expels and forms the mousse composition.

Telephonic Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAKE M. VU whose telephone number is (571)272-8148. The examiner can normally be reached on Mon-Tue and Thu-Fri 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jake M. Vu/

Jake M. Vu, PharmD, JD
Art Unit 1618